

REMARKS

Claims 1, 3-5, 7, 9, 11, 15 and 17 are pending in the application. Claim 2 has been canceled by way of the present amendment. Favorable reconsideration of the application is requested.

In the outstanding Advisory Action, issued November 30, 2005, it was indicated that Applicant's declaration under 37 CFR § 1.131 shows a draft of the application (i.e., Exhibit 1) that pre-dates the prior art date of February 13, 2001, of Fukumoto et al. and shows conception of the art as filed. However, the outstanding Advisory Action also indicates there is no showing of reasonable diligence to filing the draft application. Applicants respectfully traverse this contention by submitting copies of communications between the Applicant and the patent attorney on May 4, 2001, as Exhibit 4. Exhibit 4 shows proposed changes to the original draft of the application (i.e., Exhibit 1) by a listing of line-by-line changes to the original draft application and a marked-up version of the draft application by the inventors (Exhibit 4). In addition, Exhibit 5, dated May 30, 2001, shows a request to a local graphics firm to complete formal drawings for filing with the application. Applicants respectfully submit these documents are evidence of reasonable diligence that led up to filing the application on June 15, 2001.

If the Examiner does not agree, Applicant respectfully request a personal interview before issuance of a first Office Action in the Request for Continued Examination (RCE). Please contact Applicants representative at the phone number indicated below.

In an outstanding Advisory Action, issued on November 30, 2005, proposed amendments were not entered because they raise new issue that would require further consideration and/or search. In the outstanding Office Action, issued July 27, 2005, claim 2 was objected to for being in improper dependent form; and claims 1-5, 7, 9, 11, 15 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication No. 2001/0051987 (Fukumoto et al.) in view of U.S. Patent No. 6,301,608 (Rochkind).

Claim Objections

Claim 2 was objected to for being in improper dependent form. Claim 2 has been canceled by way of the present amendment. Therefore, Applicants respectfully submit the claim objection is moot.

U.S.C. Section 103 Rejections

Claims 1-5, 7, 9, 11, 15 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fukumoto et al. in view of Rochkind. Applicants respectfully traverse the rejection.

Applicants respectfully submit the attached declaration under 37 C.F.R. § 1.131 of prior invention in the United States to overcome the cited art of Fukumoto et al. In particular, the declaration attached hereto is copy of a draft patent application entitled “Electronic Mail System for Generating A Mail Message to Multiple Recipients With Multiple Attention Levels” (Exhibit 1) comprising numbered pages 1-19, six sheets of drawings including Figs. 1-7 (Exhibit 2), which are referred to in Exhibit 1, a cover letter of two pages signed by George Pettit (Exhibit 3) transmitting Exhibits 1 and 2. While the date on Exhibit 3 has been blocked, declarants assert the date which has been blocked out is a date prior to February 13, 2001.

From the above discussed Exhibits 1-3, it can be seen that the invention in this application was made at least prior to February 13, 2001. In the outstanding Advisory Action, issued November 30, 2005, it was indicated that Applicant’s declaration under 37 CFR § 1.131 shows a draft of the application (i.e., Exhibit 1) that pre-dates the prior art date of February 13, 2001, of Fukumoto et al. and shows conception of the art as filed.

However, the outstanding Advisory Action also indicates there is no showing of reasonable diligence in filing the draft application. Applicants respectfully traverse this contention by submitting copies of communications between the Applicant and the patent attorney on May 4, 2001, as Exhibit 4 and May 30, 2001, as Exhibit 5.

Exhibit 4 shows proposed changes to the original draft of the application (i.e., Exhibit 1) by a listing of line-by-line changes to the original draft application and a marked-up version of the draft application by the inventors (Exhibit 4). In addition, Applicants submit Exhibit 5, dated May 30, 2001, that shows a request to a local graphics firm to complete formal drawings for filing with the application. Applicants respectfully submit these documents are evidence of the reasonable diligence that led up to filing the application on June 15, 2001. Therefore, Applicants submit that Fukomoto et al. does not qualify as prior art and the combination of Fukomoto et al. and Rochkind cannot be used to reject the claimed invention. Therefore, Applicants respectfully request that the outstanding rejection be withdrawn.

In addition, Fukomoto et al. discloses an E-mail system and E-mail transmission method of broadcasting where, when transmitting a broadcasting E-mail, a sender designates a transmission destination of an emphasized part for each item.¹ In particular, Fukomoto et al. discloses the transmitting client **11** instructs the mail server **12** to transmit to each receiver the E-mail that is prepared by emphasizing and highlighting a transmission document for each receiver.²

Further, Fukumoto et al. discloses the mail server **12** allocates the transmission documents to the respective destinations, emphasizes and highlights the related part for each destination, and stores the documents in the mailbox **14**.³ Furthermore, Fukumoto et al. discloses the transmission document is transmitted to the receiving client **13** corresponding to the destination.⁴ Moreover, Fukumoto et al. discloses the screen of each receiving client **13**, the part related to the receiver in the transmission document is emphasized and displayed with a designated highlighting method.⁵

However, Fukumoto et al. nowhere discloses, as recited in claim 1:

appending to each of said addresses a tag representing an attention level for said recipients and a tag identifying said specific highlighted portion for each recipient.

¹ Fukomoto et al. at ABSTRACT.

² *Id.* at FIG. 2; and page 2, paragraph 47, lines 4-7.

³ *Id.* at FIG. 2; and page 2, paragraph 48, lines 1-4.

⁴ *Id.* at FIG. 2; and page 2, paragraph 48, lines 4-6.

⁵ *Id.* at FIG. 2; and page 2, paragraph 48, lines 6-9.

In addition, it is respectfully submitted that Fukumoto et al. nowhere discloses “determining from a tag inserted in an address field of said message whether any portion of said message is highlighted,” as recited in claim 9, “displaying on said computer terminal a pop-up table which identifies various attention levels which may be assigned to each addressee,” as recited in claims 11 and 15; and “determining from a tag inserted in a field of said message whether any portion of said message is highlighted,” as recited in claim 17. Therefore, it is respectfully submitted that Fukumoto et al., if it did qualify as prior art, does not disclose the claimed invention.

In addition, the outstanding Office Action acknowledges other deficiencies of Fukomoto et al. and attempts to overcome these deficiencies with Rochkind.⁶ However, Rochkind cannot overcome the deficiencies of Fukomoto et al. as discussed below.

Rochkind discloses a method and apparatus that provides personalized mailbox filters where the electronic mailbox filters or sorts messages according to personalized or customized rules set by the owner of the mailbox through the use of address extensions.⁷

However, Rochkind nowhere discloses “a tag identifying said specific highlighted portion for each recipient,” as recited in claim 1; “determining from a tag inserted in an address field of said message whether any portion of said message is highlighted,” as recited in claim 9, “displaying on said computer terminal a pop-up table which identifies various attention levels which may be assigned to each addressee,” as recited in claims 11 and 15; and “determining from a tag inserted in a field of said message whether any portion of said message is highlighted,” as recited in claim 17. Thus, Rochkind cannot overcome the deficiencies of Fukumoto et al.

Therefore, it is respectfully submitted that neither Fukomoto et al. nor Rochkind, whether taken alone or in combination, disclose, suggest or make obvious the claimed invention and thus, claims 1, 9, 11, 15 and 17, and claims dependent thereon, patentably distinguish thereover.

⁶ Outstanding Office Action, paragraphs 11, 17 and 19.

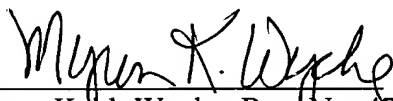
⁷ Rochkind at ABSTRACT.

Conclusions

In view of the foregoing, favorable reconsideration is believed to be in order. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 09-0458, under Order No. 20136-00324-US from which the undersigned is authorized to draw.

Dated: December 27, 2005

Respectfully submitted,

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